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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,149	09/24/2003	Tomoyuki Atsumi	1018987-000054	2756
21839 7590 02/04/2011 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404				
EXAMINER NGUYEN, ALLEN H				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
02/04/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

10/668,149

Applicant(s)

ATSUMI, TOMOYUKI

Examiner

Allen H. Nguyen

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-13, 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 16-19 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/07/2010 has been entered.

Response to Arguments

2. Applicant's arguments filed 11/09/2010 have been fully considered but they are not persuasive.

3. With respect to Applicant's arguments that "The portion of Rogers does not disclose that a receiving unit extracts the destination information from a mail replying to an Internet mail".

In response, Fuller discloses wherein the notifying unit sends the send information via a voice message (apparatus 60 to call a telephone number and output a voice message notifying him that he has received a facsimile message which has been stored in his mailbox; see col. 7, lines 50-65), and the receiving unit extracts the destination information from a replying (he / user can go to apparatus 60 and request the apparatus 60 to extract / print his facsimile message on the local facsimile machine; col. 8, lines 5-7).

Fuller '156 does not explicitly show the send information via an internet mail.

However, the above-mentioned claimed limitation is well known in the art as evidenced by Hou '384. In particular, Hou '384 teaches the send information via an internet mail (col. 2, lines 53-55 and col. 3, lines 20-21).

In view of the above, having the system of Fuller and then given the well-established teaching of Hou, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Fuller as taught by Hou to include: the send information via an internet mail, since Hou stated in col. 2, lines 35-40 that such a modification would ensure a remote Internet fax machine to send a facsimile even though the Internet fax machine is not nearby and thus the Internet fax machine, to send any documents or images stored on a computer to and from anywhere in the world, and to extend the capabilities and usefulness of the Internet fax machine.

4. With respect to Applicant's arguments that "the provision of the portable communication device provides advantages not realized by Rogers or Fuller either alone or in combination".

In response, Fuller discloses the portable communication device including: a third receiving unit (i.e., user in travel; col. 2, lines 20-25) operable to receive the send information from the notifying unit in the fax data transmission device (in 10 / 60, figs. 1, 4), when designated as the send information destination (individual has a pager or beeper, he can "tell" apparatus 60 to call

Art Unit: 2625

his pager or beeper number and output a code to tell him that he has received a facsimile message which has been stored in his mailbox; col. 7, lines 50-60);

a replying unit operable to send the destination information to the fax data transmission device (sending the facsimile data on demand to the person to which the facsimile data was addressed, col. 2, lines 20-30. Also, col. 8, lines 5-8 indicated that user can go to apparatus 60 and request the apparatus 60 to extract / print his facsimile message on the local facsimile machine).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 14, 16-17, 19, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuller et al. (US 5,224,156) in view of Hou (US 7,068,384).

Regarding claim 14, Fuller '156 discloses a fax data transmission device (Facsimile enhancement apparatus 10 / 60, figs. 1, 4) comprising:

a first storing unit (first memory means 24, fig. 1) operable to store fax data and an identifier for identifying the fax data, in correspondence with each other (The facsimile enhancement apparatus 10 will intercept the incoming data or message and store the information/data in an appropriate mailbox in first

Art Unit: 2625

memory means 24; see col. 4, lines 35-45);

a second storing unit (second memory means 26, fig. 1) operable to store information showing a correspondence between an original destination (local facsimile machine, fig. 1) of the fax data and a send information destination (The information is digitized by the fax modem chip 18 and stored in second memory means 26. The user is prompted by the LCD display 30 to enter the telephone number (step 90) of the remote location at which he wishes to be notified; see col. 8, lines 25-40), the send information destination being a destination of send information which includes the identifier and a notification (a notification on the local facsimile machine which will include the time the facsimile message is received, the number of the mailbox in which the message is stored and the sender ID, col. 6, lines 45-50) that the fax data identified by the identifier is going to be sent (apparatus 60 to call a telephone number and output a message notifying him that he has received a facsimile message which has been stored in his mailbox; see col. 7, lines 45-60);

a notifying unit (in 10 / 60, figs. 1, 4) operable to send the send information to the send information destination corresponding to the original destination of the fax data, with reference to the information stored in the second storing unit (the facsimile enhancement apparatus 10 can cause facsimile messages sent to him to be delivered to a memory location and that he be notified that he has a facsimile message waiting for him; see col. 2, lines 53-60);

a receiving unit (in 60, fig. 4) operable to receive as a reply to the send information (User can specify to the facsimile enhancement apparatus 60 the

Art Unit: 2625

type of notification; col. 7, lines 45-50), destination information from the send information destination for specifying a destination to which the fax data should actually be sent (he may have the facsimile message automatically forwarded to another facsimile machine at a remote location. Second, he may call from a facsimile machine at a remote location and instruct apparatus 60 to transmit the facsimile message immediately on the same phone call; see col. 7, lines 65-68 and col. 8, lines 1-5), and extract the destination information from the reply (user may call from a facsimile machine at a remote location and instruct apparatus 60 to transmit the facsimile message on the same phone call, therefore, the user must tell the facsimile machine at a remote location where to send the fax message, and facsimile machine at a remote location must extract where to send/destination information so that the facsimile machine at a remote location know where to send); and

a sending unit (in 10 / 60, figs. 1, 4) operable to send the fax data to the destination specified by the extracted destination information (user may call from a facsimile machine at a remote location and instruct apparatus 60 to transmit the facsimile message on the same phone call, therefore, the user must tell the facsimile machine at a remote location where to send the fax message, and facsimile machine at a remote location must extract where to send/destination information so that the facsimile machine at a remote location know where to send; col. 7, lines 65-68 and col. 8, lines 1-7).

wherein the notifying unit sends the send information via a voice message (apparatus 60 to call a telephone number and output a voice message notifying

him that he has received a facsimile message which has been stored in his mailbox; see col. 7, lines 50-65), and the receiving unit extracts the destination information from a replying (he / user can go to apparatus 60 and request the apparatus 60 to extract / print his facsimile message on the local facsimile machine; col. 8, lines 5-7).

Fuller '156 does not explicitly show the send information via an internet mail.

However, the above-mentioned claimed limitation is well known in the art as evidenced by Hou '384. In particular, Hou '384 teaches the send information via an internet mail (col. 2, lines 53-55 and col. 3, lines 20-21).

In view of the above, having the system of Fuller and then given the well-established teaching of Hou, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Fuller as taught by Hou to include: the send information via an internet mail, since Hou stated in col. 2, lines 35-40 that such a modification would ensure a remote Internet fax machine to send a facsimile even though the Internet fax machine is not nearby and thus the Internet fax machine, to send any documents or images stored on a computer to and from anywhere in the world, and to extend the capabilities and usefulness of the Internet fax machine.

Regarding claim 16, Rogers '386 teaches the fax data transmission device (Facsimile Apparatus 1, fig. 1), wherein the notifying unit (Third E-Mail Service Unit 18, fig. 2) places the identifier in a message body of the Internet mail ("Tag"

Art Unit: 2625

is attached to the second call 645 in the call alert box to provide useful information to individual users, col. 39, lines 15-50, fig. 6b).

Fuller '156 does not explicitly show the send information via an internet mail.

However, the above-mentioned claimed limitation is well known in the art as evidenced by Hou '384. In particular, Hou '384 teaches the send information via an internet mail (col. 2, lines 53-55 and col. 3, lines 20-21).

In view of the above, having the system of Fuller and then given the well-established teaching of Hou, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Fuller as taught by Hou to include: the send information via an internet mail, since Hou stated in col. 2, lines 35-40 that such a modification would ensure a remote Internet fax machine to send a facsimile even though the Internet fax machine is not nearby and thus the Internet fax machine, to send any documents or images stored on a computer to and from anywhere in the world, and to extend the capabilities and usefulness of the Internet fax machine.

Regarding claim 17, Fuller '156 discloses the fax data transmission device (10 / 60, figs. 1, 4), wherein the destination information includes location information showing a location of an external device (i.e., If the individual has a pager or beeper, he can "tell" apparatus 60 to call his pager or beeper number and output a code to tell him that he has received a facsimile message which has been stored in his mailbox; see col. 7, lines 45-60),

the destination to which the fax data should actually be sent is determined based on the location information (The user may choose to have the facsimile enhancement apparatus 60 to forward all facsimile messages to another specified location, col. 9, lines 50-55).

Regarding claim 19, Fuller '156 discloses the fax data transmission device (in 10 / 60, figs. 1, 4) further comprising:

a notification destination information receiving unit operable to receive the information showing the correspondence between the original destination of the fax data (remote location/local fax machine, fig. 1) and the send information destination (12, fig. 1), from outside of the fax data transmission device (user is prompted to enter the telephone number (step 90) of the remote location at which he wishes to be notified, col. 8, lines 35-40),

wherein the second storing unit (memory 26, fig. 1) stores the information received by the notification destination information receiving unit (The facsimile enhancement apparatus 10 can also print a notification on the local facsimile machine which will include the time the facsimile message is received, the number of the mailbox in which the message is stored and the sender ID, col. 6, lines 45-65).

Regarding claim 24, Rogers '386 teaches the fax data transmission device (Facsimile Apparatus 1, fig. 1), wherein the identifier is included in a message

Art Unit: 2625

body of the Internet mail ("Tag" is attached to the second call 645 in the call alert box to provide useful information to individual users, col. 39, lines 15-50, fig. 6b).

Fuller '156 does not explicitly show the send information via an internet mail.

However, the above-mentioned claimed limitation is well known in the art as evidenced by Hou '384. In particular, Hou '384 teaches the send information via an internet mail (col. 2, lines 53-55 and col. 3, lines 20-21).

In view of the above, having the system of Fuller and then given the well-established teaching of Hou, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Fuller as taught by Hou to include: the send information via an internet mail, since Hou stated in col. 2, lines 35-40 that such a modification would ensure a remote Internet fax machine to send a facsimile even though the Internet fax machine is not nearby and thus the Internet fax machine, to send any documents or images stored on a computer to and from anywhere in the world, and to extend the capabilities and usefulness of the Internet fax machine.

7. Claims 22-23 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Fuller et al. (US 5,224,156) in view of Rogers et al. (US 5,946,386).

Regarding claim 22, Fuller '156 discloses a fax data transmission system (Figs. 1, 4) comprising a fax data transmission device (10/60, figs. 1, 4), an information communication device (12 / 60, figs. 1, 4), and a portable

Art Unit: 2625

communication device (i.e., remote telephone / voice mail system, since mobile phones generally inherently have voicemail as a standard network feature; see col. 2, lines 65-68 and col. 8, lines 53-55, fig. 6),

the information communication device including:

a first sending unit operable to send information showing a correspondence between an original destination of fax data and a send information destination, to the fax data transmission device (The facsimile enhancement apparatus 10 can also print a notification on the local facsimile machine which will include the time the facsimile message is received, the number of the mailbox in which the message is stored and the sender ID; see col. 6, lines 45-50),

the fax data transmission device including:

a first receiving unit (in 10/60, figs. 1, 4) operable to receive the information from the first sending unit in the information communication device (a message sent in facsimile compatible form over a telephone system from a first location to a second location to be received at the second location; see Abstract);

a first storing unit (first memory means 24, fig. 1) operable to store the fax data and an identifier for identifying the fax data, in correspondence with each other (The facsimile enhancement apparatus 10 will intercept the incoming data or message and store the information/data in an appropriate mailbox in first memory means 24; see col. 4, lines 35-45);

a second storing unit (second memory means 26, fig. 1) operable to store the information received by the first receiving unit (The information is digitized by

the fax modem chip 18 and stored in second memory means 26. The user is prompted by the LCD display 30 to enter the telephone number (step 90) of the remote location at which he wishes to be notified; see col. 8, lines 25-40);

a notifying unit (in 10 / 60, figs. 1, 4) operable to send send information to the send information destination corresponding to the original destination of the fax data with reference to the information stored in the second storing unit (the facsimile enhancement apparatus 10 can cause facsimile messages sent to him to be delivered to a memory location and that he be notified that he has a facsimile message waiting for him; see col. 2, lines 53-60), the send information including the identifier and a notification (a notification on the local facsimile machine which will include the time the facsimile message is received, the number of the mailbox in which the message is stored and the sender ID, col. 6, lines 45-50) that the fax data identified by the identifier is going to be sent (apparatus 60 to call a telephone number and output a message notifying him that he has received a facsimile message which has been stored in his mailbox; see col. 7, lines 45-60);

a second sending unit (in 10 / 60, figs. 1, 4) operable to send the fax data to the destination specified by the destination information (user may call from a facsimile machine at a remote location and instruct apparatus 60 to transmit the facsimile message on the same phone call, therefore, the user must tell the facsimile machine at a remote location where to send the fax message, and facsimile machine at a remote location must extract where to sent/destination information so that the facsimile machine at a remote location know where to

Art Unit: 2625

send),

the portable communication device including:

a third receiving unit (i.e., user in travel; col. 2, lines 20-25) operable to receive the send information from the notifying unit in the fax data transmission device (in 10 / 60, figs. 1, 4), when designated as the send information destination (individual has a pager or beeper, he can "tell" apparatus 60 to call his pager or beeper number and output a code to tell him that he has received a facsimile message which has been stored in his mailbox; col. 7, lines 50-60);

a replying unit operable to send the destination information to the fax data transmission device (sending the facsimile data on demand to the person to which the facsimile data was addressed, col. 2, lines 20-30. Also, col. 8, lines 5-8 indicated that user can go to apparatus 60 and request the apparatus 60 to extract / print his facsimile message on the local facsimile machine).

Fuller '156 does not explicitly show a second receiving unit operable to receive destination information for specifying a destination to which the fax data should actually be sent, as a reply to the send information.

However, the above-mentioned claimed limitations are well known in the art as evidenced by Rogers '386. In particular, Rogers '386 teaches a second receiving unit (101, fig. 1) operable to receive destination information for specifying a destination to which the fax data should actually be sent, as a reply to the send information (When notified, the destination party 111, 113 may review the list of unread Fax or data messages and then may request that the Fax or data message be transported to their workstation 114 via the digital network(s)

109, from whence it can be viewed, printed, archived and treated as any other such file; see col. 40, lines 45-50).

In view of the above, having the system of Fuller and then given the well-established teaching of Rogers, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Fuller as taught by Rogers to include: a second receiving unit operable to receive destination information for specifying a destination to which the fax data should actually be sent, as a reply to the send information, since Rogers stated in col. 1, lines 45-47 that such a modification would ensure the system alters the architecture and philosophy of the past, providing the users an array of new features and functions and expanded existing features.

Regarding claim 23, Fuller '156 discloses the fax data transmission system (Facsimile enhancement apparatus 10 / 60, figs. 1, 4), wherein the second receiving unit (in 10 / 60, figs. 1, 4) extracts the destination information from the reply to the send information (user can go to apparatus 60 and request the apparatus 60 to extract / print his facsimile message on the local facsimile machine; col. 8, lines 5-8).

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuller et al. (US 5,224,156) in view of Hou (US 7,068,384), and further in view of Shibata (US 6,825,955).

Regarding claim 18, the combination of Fuller '156 and Hou '384 does not explicitly show the fax data transmission device, being a multi-functional image forming device which has a copy function of reading a document and forming an image on a recording sheet based on data obtained by reading the document, and a print function of forming an image on a recording sheet based on incoming data.

However, the above-mentioned claimed limitations are well known in the art as evidenced by Shibata '955. In particular, Shibata '955 teaches the fax data transmission device (Facsimile Apparatus 1, fig. 1), being a multi-functional image forming device which has a copy function of reading a document and forming an image on a recording sheet based on data obtained by reading the document (i.e., the facsimile main controller 10 includes an image reading unit, such as a scanner, for reading image data from an original document, which is then handled as facsimile image data to be transmitted to the local communications terminals; Col. 6, lines 1-5), and a print function of forming an image on a recording sheet based on incoming data (i.e., the facsimile main controller 10 further includes an image writing unit, such as a laser printer, for printing onto a recording sheet facsimile image data which has been received from one of the local communications terminals; Col. 6, lines 5-10).

In view of the above, having the system of Fuller and Hou and then given the well-established teaching of Shibata, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Fuller and Hou as taught by Shibata to include: the fax data

Art Unit: 2625

transmission device, being a multi-functional image forming device which has a copy function of reading a document and forming an image on a recording sheet based on data obtained by reading the document, and a print function of forming an image on a recording sheet based on incoming data, since Shibata stated in col. 1, lines 15-20 that such a modification would enhance a unique communications apparatus which is capable of transmitting and receiving facsimile image data through the Internet using its low cost communications capability.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen H. Nguyen whose telephone number is (571)270-1229. The examiner can normally be reached on M-F Flex hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KING Y. POON can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

/Allen H. Nguyen/
Examiner, Art Unit 2625